

REMARKS

The present application comprises claims 1-149. Claims 1, 22, 36, 44, 56, 58, 64, 81, 104, 105, 107-109, 113, 120, and 125 have been currently amended. Claims 148 and 149 have been currently added.

This response refers primarily to the patentability of the independent claims. The patentability of the dependent claims follows at least for the reason of being dependent on an independent claim that is patentable. The applicants reserve the right to argue the dependent claims later and respectfully request a personal interview if the Examiner feels an allowance is not forthcoming.

RESTRICTION

The Examiner stated that claims 126-147 are directed to an invention that is independent or distinct from the invention originally claimed, and therefore these claims are withdrawn from consideration.

Applicants respectfully disagree.

While claims 1-125 and 126-147 may relate to distinct inventions, claims 1-125 and 126-147 are not directed to independent inventions as defined by MPEP §802. MPEP §802 states that the term independent means that there is no disclosed relationship between the two or more subjects disclosed, that is they are unconnected in design, operation or effect. All the claims of the present application are directed to spacers and methods of their use and therefore are related (i.e., are not independent, but may be separately patentable).

As stated in MPEP §808.02, in order to insist upon restriction of related inventions the Examiner must show one of: separate classification, a separate status in the art, or a different field of search. As all the claims relate to expandable spacers and methods of their use they are classified together, should be searched together and have the same status in the art.

Furthermore, in order for a restriction to be proper, there must be a serious burden on the Examiner (MPEP §803). As the claims are closely related, such burden seems to be absent.

Applicants therefore request that the Examiner retract the restriction and examine claims 126-147.

SPECIFICATION

The Examiner states that the continuing data is not clear and also that no timely reference was made to the US application. Applicants have amended the specification to remove these references.

Claim 120 was objected to due to the use of the word combination "an extensions". The claim was amended to clarify the language.

CLAIM REJECTIONS - 35 U.S.C. §112

The Examiner stated that the claimed ranges "on at least 40% of said body" and "at least 50% of the surface area" lack original support. Applicants respectfully direct the Examiner to page 16, lines 8-13 where these ranges appear in the originally filed application.

The Examiner rejected claims 107-109 under 35 U.S.C §112, second paragraph, as being indefinite. Applicants respectfully traverse the rejection.

Claims 107, and 108 were amended for clarity to remove unnecessary language. Also, claims 107-109 were amended to relate to the spacer geometry as "expanded spacer geometry".

The contact surface refers to that portion of the expanded spacer geometry (i.e., the virtual surface that externally bounds the expanded spacer) that contacts the vertebrae (i.e., is in the close vicinity of the vertebrae), as there are areas of the spacer geometry that do not contact vertebrae (e.g., if the spacer is between two vertebra below and above, the spacer does not contact vertebrae on its sides). As the vertebrae and/or the spacer are not necessarily of the same surface shape and/or are not necessarily smooth, the expanded spacer geometry does not touch the vertebrae at all points even in the area included in the contact surface. The claim states that the tips, which actually contact the vertebrae, cover at least 20%, 40% or 60% of the contact surface.

The Examiner rejected claim 113 under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants amended the claim to state specifically, what was already implicit, that the body cross section does not include the extensions.

CLAIM REJECTIONS - 35 U.S.C. §102

The Examiner states that claims 1-16, 19-24, 27, 28, 30, 31, 34-49, 51-68, 70, 78-81, 84-86, 89-95 and 99-125 are rejected under 35 U.S.C. §102(b) as being anticipated by Pisharodi (U.S. Patent No. 5,693,100) or under 35 U.S.C. §103 as being obvious in view of Pisharodi and optionally one or more other references. Applicants respectfully disagree but have amended the claims to further the issuance of the application. As discussed below, Pisharodi is missing an element, "at least two axially displaced extensions", of claims 1, 113 and 125 and therefore the Examiner has not established a *prima facie* case of anticipation or obviousness against any of the claims.

Claim 1 requires at least two axially displaced extensions. In contrast, Pisharodi shows extensions all at a same axial location and each formed of two legs (34 and 36, Figs. 6 and 7). All the extensions are in the same axial position of the implant of Pisharodi. Even if each of the two

legs (34 and 36) is considered a separate leg extension, the leg extensions are not axially displaced from each other, as the legs touch each other, while axially displaced (as opposed to "axially contiguous") requires that the extensions be separated by an axial extent that does not belong to one of the two extensions. It should be noted that in some embodiments of the invention, three contiguous extensions are provided, with the middle extension serving as a separation.

Applicants also note the title of Pisharodi: "Middle Expandable Intervertebral Disk Implant". It is only the middle that expands, and therefore only one axial position is provided.

The dependent claims are patentable at least because claim 1 is patentable. Nonetheless, at least some of the dependent claims add further patentability over Pisharodi. Claim 9, for example, requires that the slits are not parallel to the tube axis. In Pisharodi, the slits are all parallel. Contrary to that stated by the Examiner, the connections between the legs (34 and 36) are not slits, but rather hinges 46 (col. 5, line 6). If they were slits, the legs would not be connected to each other to form the extensions. Claim 11, for example, requires that the slits are arranged in pairs of different lengths. In Pisharodi, the slits are all of the same length.

Claims 113 and 125 require at least two axially displaced extensions. As discussed regarding claim 1 this is not taught or suggested by Pisharodi.

However, to further the issuance of the application, claim 1 was amended to specify that the plurality of slits are axially displaced. This is clearly not shown in Pisharodi, where only one slit (on either side) defines both 34 and 36. Claim 125 was amended in a similar manner.

Claim 113 was amended to include a limitation of at least three axially displaced extensions, which Pisharodi clearly does not show. New dependent claims 148 and 149 were added, with a similar limitation.

ADDITIONAL AMENDMENTS

Claims 56, 58, 64 and 113 were amended to state specifically that the cross-section refers to the trans-axial cross-section. This was inherent in the claim and was made explicit for clarity.

Claims 22, 44 and 81 were amended to correct typographical errors. Claim 36 was amended to provide antecedent for "the tip".

Claims 104 and 105 were amended to correct an inadvertent mistake in their formulation. In the unamended language, these claims were tautologies as the expanded geometry is always larger than the tube, so twice or for times the expanded geometry would also always be larger than the tube. It is clear from the claims and from the specification that the amended language is what was originally meant.

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CONCLUSION

In view of the above remarks, applicants submit that the claims are patentable over the prior art. If the Examiner does not agree regarding one or more of the claims, but is of the opinion that a telephone conversation may forward the present application toward allowance, applicants respectfully request that the Examiner call the undersigned at 1 (877) 428-5468. Please note that this is a direct *toll free* number in the US that is answered in the undersigned's Israel office. Israel is 7 hours ahead of Washington. Our normal work week is Sunday through Thursday.

An allowance on the merits is respectfully requested.

Respectfully submitted,
O. GLOBERMAN et al.

Paul Fenster Reg 33,877
fa/ Maier Fenster
Reg. No. 41,016

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William H. Dippert, Esq.
Reed Smith LLP
599 Lexington Avenue, 29th Floor
New York, NY 10022-7650